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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/651,092	08/29/2003	Joseph M. Perron	PERRON-1	7733
32132	7590	03/07/2005	EXAMINER	
LAMORTE & ASSOCIATES P.C. P.O. BOX 434 YARDLEY, PA 19067			LAYNO, BENJAMIN	
			ART UNIT	PAPER NUMBER
			3711	

DATE MAILED: 03/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

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<b>Office Action Summary</b>	<b>Application No.</b> 10/651,092	<b>Applicant(s)</b> PERRON, JOSEPH M.	
	<b>Examiner</b> Benjamin H. Layno	<b>Art Unit</b> 3711	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

**A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.**

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 06 December 2004.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,3,5,6,8,9,12 and 13 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 3, 5, 6, 8, 9, 12 and 13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### DETAILED ACTION

1. Applicant's arguments filed 12/06/05 have been fully considered but they are not persuasive. The rejections follow.

#### ***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1, 3, 5 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nolte.

The Applicant is referred to the description of Nolte in the first Office action.

The Applicant has argued that in the present invention chess is only played within the chessboard area of the game board when only two players remain. Chess is played using only the chess pieces that have been moved into the chessboard section of the game board. However, in Nolte's game, the chessmen play by the rules of traditional western chess at all times and at all points of the board.

The Examiner takes the position that in Nolte's game, a game is played on Nolte's game board in areas 10-18 that is different than traditional western chess, see col. 5, line 50 to col. 7, line 72, see Figs. 1, 4, 10, 10A, 11A-11G. In this game the rules of traditional western chess are **not** followed. Nolte's game may be played by four, six or eight players (there are only two player in traditional western chess). In Nolte's game additional chess pieces are used (traditional western chess only uses 32 chess pieces)

Also in Nolte's game nine 8 X 8 boards 10-18 are used (only one 8 X 8 board is used in traditional western chess), and the chess pieces are placed on these boards that is clearly different than the placement of chess pieces in traditional western chess, see Figs. 1, 4, and 10.

In Nolte's game may be played by four, six or eight players. According to Nolte's rules, a player may checkmate an opposing player's king. If a player's king is checkmated, all of the chessmen of that player are removed, col. 7, lines 67-72. Therefore, the player is eliminated from the game. As players are eliminated from the game it is inherent that two players will remain. In order to make Nolte's game more simple to play, it would have been obvious to move the remaining chess pieces to the center board, and change the rules of Nolte's game allowing the last two players to play traditional western chess to decide the winner.

4. Claims 8, 9, 12 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tourville in view of Temple.

The Applicant is referred to the description of Tourville in the first Office action.

The patent to Tourville discloses a game board having a plurality of areas, Figs. 1-4. The game board comprises play spaces that extend throughout the plurality of areas including control spaces, col. 1, lines 54-66. In the center of the game board is a **chessboard area** that comprises **at least** sixty-four play spaces arranged in **at least** 8 columns and **at least** 8 rows. The plurality of areas also includes a second area of play, the outside board, Figs. 1-4, having fifty-six spaces 1-56. Tourville further comprises game pieces, "ship markers" that are capable of being called traditional western chess

pieces. The term "traditional western chess game pieces.....a king, a queen...." is simply a name labeled to game pieces. These names do not provide any physical structural limitation to the game pieces, and thus have no limiting affect in apparatus claims. Tourville further includes placement cards, "Quazi cards", for identifying where players should place the game pieces, col. 5, lines 1-11. Determining when the placement cards are used, e.g. at the beginning of the game, is simply a game rule. In apparatus claims only the elements having physical structure are given patentable weight. Game rules have no physical structure, and therefore have no limiting affect.

5. The Applicant is referred to the combination of Tourville and Temple in the first Office action. The Applicant attacked the Temple reference individually by arguing that Temple makes no disclosure concerning a game with a defined chessboard area or the use of chess pieces to play chess. The Temple patent also has no mention of placement cards used to position pieces at the start of the game. In response to applicant's arguments against the Temple reference individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

### **Conclusion**

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

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§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

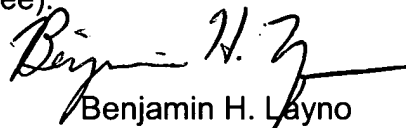
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Benjamin H. Layno whose telephone number is (571) 272-4424. The examiner can normally be reached on Monday-Friday, 1st Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Greg Vidovich can be reached on (571)272-4415. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Benjamin H. Layno  
Primary Examiner  
Art Unit 3711

bhl